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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,325	06/02/2000	Guy Nathan	871-83	7170

23117 7590 01/13/2005  
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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/585,325

**Applicant(s)**

NATHAN ET AL.

**Examiner**

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Response to Amendment***

1. Amendment received on September 24, 2004 is acknowledged and entered. Claims 15 and 23 have been amended. Currently claims 15-30 are pending for examination.

***Response to Arguments***

2.1. The applicant argues (see Remarks, page 8) that Nathan/Kleiman does not disclose generating a file containing request based on actions from the user's terminal and therefore does not teach enabling a selection/an advance selection to be made by the user. The examiner respectfully disagrees for the following reasons:

Nathan clearly discloses generating a file containing requests based on actions from the user's terminal and teaches enabling a selection/an advance selection by the user is a prior art (see at least col.8, lines 9-40, "*....Audiovisual reproduction systems according to prior art enable downloading of new selections through a distribution network and a host server. However, commands for new selections must be made through the touch screen (33) and a module in the operating system of each reproduction system, and in some cases requires operator intervention. In order to avoid repeated movements of the operator to order new selections, the operating system has a procedure integrated into a module of the reproduction system by which the user can choose at least one new selection in a list. This procedure consists of starting to read the file stored on the memory means which displays a special screen on the display means (62). This screen contains a window in which a list of songs is displayed in the form of a popup menu. This list corresponds to selections that are not yet available on the audiovisual reproduction system, but which could be downloaded on the reproduction system. Thus, a message is displayed on the screen inviting users to select the new song(s) that they would like to have on the audiovisual reproduction system simply by touching the touch screen (33) on the title of the required*

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*song. Users' choices are memorized in a file stored on the memory means, which is updated whenever a user chooses a new selection in the list. ....the reproduction system sends a request to the host server to request that the selection is downloaded. Thus, new selections are ordered and downloaded without action by the manager or the operator, which considerably simplifies the operation of ordering new selections " . Note: The user can interact with the audiovisual reproduction system via touch screen to select desired songs from the said file. ).*

The applicant further argues that Nathan/Kleiman does not teach the newly added limitation in the amended claims 15 and 23 that is making an advance selection by a user location other than the jukebox. The argument is moot in view of new grounds of rejection necessitated due to amendment.

In view of the foregoing, the rejection of claims 15-30 is maintained.

It is a Final action.

### ***Claim Rejections - 35 USC § 103***

3. Claims 15-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan (US Patent 6,336,219) and further in view of Kleiman (US Patent 5,959,945):

Nathan teaches the claimed limitations of claims 15-30, that is a method, device and system where a jukebox and a server can communicate with each other and receive messages and store them, display the identity of the destination equipment, receive the selection to be played on the destination equipment, special requests are recorded and downloaded on a file, execution of the request at a given time and date, making payments, (at least see, abstract, FIG.1. Note: Fig.1 which represents the electrical scheme of Patent '219 is similar to that displayed in the Fig.1 of the claimed invention,

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abstract, col.1, lines 15-38, col.1, line 66-col.2, line 24, col.4, lines 63-67, col.8, line 9-col.10, line 22. Note: Nathan's teaching of "enable a particular song to be played at a defined time ", relates to play the selected/requested in advance songs at a later date at the destination equipment). Nathan, further, teaches to record a voice message to be played before the song to be played (see at least col.6, lines 7-16, "*..The IRM module ....reproduction of complete selections ...spoken promotional announcements of new musical selections....*". Note: just like these spoken promotional announcements, voice messages can be recorded and played before playing of the songs. Also see col.8, line 60-col.9, line 14, "*....Another feature of the reproduction system according to the invention is to enable a particular song to be played at a defined time simultaneously on at least one determined reproduction system. For example, this feature may be used to promote a new album or a concert given by a singer. For example, this feature could be used to play the title song of a singer's new album on all reproduction systems, on the day that it is distributed in the shops. This feature can also be used to distribute a song by this singer on reproduction systems located close to the location at which a concert given by the singer will shortly be held. Playing a particular song at a particular moment on at least one particular reproduction system is initiated by a series of orders contained in a file located on each audiovisual reproduction system. The orders contained in the file determine which song should be played and the moment(s) at which it should be played. Advantageously, the file containing orders for execution of the particular song at a particular moment is downloaded on each reproduction system concerned through the host server and the distribution network. The orders contained in the file will be executed when the audiovisual reproduction system reads this file..... " .).*

Nathan also teaches that the operating software is built up around a library of tools and services (see at least col.5, lines 17-27) and these tools and services may well include C++ language using OOP-Object oriented programming methodology. C++ language and OOP-object oriented programming methodology was well-known tools at

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the time of the invention to be used and applied to a messaging interface of an electronic messaging system such that a set of OOP classes and objects for the messaging interface can be provided.

Nathan clearly discloses that generating a file containing requests based on actions from the user's terminal and teaches enabling a selection/an advance selection by the user is a prior art (see at least col.8, lines 9-40, "....Audiovisual reproduction systems **according to prior art** enable downloading of new selections through a distribution network and a host server. However, commands for new selections must be made through the touch screen (33) and a module in the operating system of each reproduction system, and in some cases requires operator intervention. In order to avoid repeated movements of the operator to order new selections, **the operating system has a procedure integrated into a module of the reproduction system by which the user can choose at least one new selection in a list. This procedure consists of starting to read the file stored on the memory means which displays a special screen on the display means (62). This screen contains a window in which a list of songs is displayed in the form of a popup menu. This list corresponds to selections that are not yet available on the audiovisual reproduction system, but which could be downloaded on the reproduction system. Thus, a message is displayed on the screen inviting users to select the new song(s) that they would like to have on the audiovisual reproduction system simply by touching the touch screen (33) on the title of the required song. Users' choices are memorized in a file stored on the memory means, which is updated whenever a user chooses a new selection in the list. ....the reproduction system sends a request to the host server to request that the selection is downloaded. Thus, new selections are ordered and downloaded without action by the manager or the operator, which considerably simplifies the operation of ordering new selections "** . Note: The user can interact with the audiovisual reproduction system via touch screen to select desired songs from the said file. ).

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Nathan does not disclose an advance selection by a user from a location other than the jukebox. However, Nathan discloses an advance selection of songs by the operator by generating a file and then downloading the file on any audiovisual reproduction system [jukebox] for playing of selected songs contained in the file (see at least col.8, lines 41-59, “ *Advantageously, in order to avoid the operator needing to move to order new selections, the operator is also able to download new selections onto an audiovisual reproduction system without using the touch screen in the reproduction system. In order to use this feature, the operator must have a computer connected to the reproduction systems host server through a data distribution network. The operator prepares a list of new selections to be downloaded and then sends a request to the host server through the distribution network. **This request includes the list of new selections to be downloaded and the identification of the reproduction system on which the new selections are to be downloaded. When the host server receives this request, the new songs on the list will be downloaded onto the memory means of the reproduction system corresponding to the identification. After these new selections have been received, the reproduction system updates the list of available musical selections. Thus, the new selection control operation is carried out without any need for the operator to move.** “.).* In view of Nathan’s teaching that operator can make advance selection of songs, generate a file and store the selected songs in a file to be downloaded to any identified audiovisual production system [jukebox] it would have been obvious to one of an ordinary skill in the art at the time of the applicant’s invention to have modified Nathan to incorporate the feature of letting users communicate with the operator, by any well-known means such as Internet, telephone, e-mail, etc. at the time of the applicant’s invention to convey their advance selection to be downloaded on any identified audiovisual reproduction system because it would enable the users to order playing of selections on birthday parties/ weddings/any special gatherings of their sons, daughters, friends, parents, etc. .

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Nathan does not show ordering in advance selected songs for an event and that the communication network is Internet. However, Kleiman, in the same field of distributing music to a plurality of Jukeboxes, teaches ordering in advance selected songs for an event and that the communication network is Internet(at least see, col.4, lines 21-59, "...A music hierarchy system exists in the juke box for determining customer preferences...It is further object of the present invention to provide...with music on demand and .....music based on local user needs at deferred times ...". Note: customer preferences and music on demand based on local user needs at deferred times in Kleiman relate to customer's selection and ordering in advance for a desired event as claimed in the application. Also, see col.5, line 60-col.8, line 67, col.9, line 59-col.10, line 17. As regards the use of Internet, see col.3, lines 42-44, " Songs may be transferred through the Internet....",). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan to include the concept of ordering in advance selected songs for an event and transferring the songs via Internet, as shown in Kleiman. Doing so would help the users to enable a particular selection of songs to be played at a remote destination at a defined time, as suggested in both Nathan (col.8, lines 60-63) and Kleiman (col.4, lines 37-40).

Nathan/Kleiman does not teach displaying a list of events and selecting an event. Official Notice is taken of both the concepts and benefits of displaying a list of events and to selecting an event in the field of events related to social expressions like, bridal shower, baby shower, wedding, birthday, funerals, graduation, anniversary events enabling the user to select one of them and then making it convenient and easy to choose the item, like greeting card, gift, for that event. It would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan/Kleiman to include the feature of displaying a list of events and selecting an event for playing a



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selection of songs. Doing so would make it convenient and easier for the user, as in the case of selecting greeting cards and gifts, to select the songs as per his preference and required by the occasion.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read 'Yogesh C Garg', written over a horizontal line.

Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
January 8, 2005